ATTORNEY DOCKET NO.
~~075635~~.0113 (10-00-001)

PATENT APPLICATION
09/737,697

In the United States Patent and Trademark Office
on Appeal from the Examiner to the Board
of Patent Appeals and Interferences

In re Application of:	Thomas H. Slaight et al.
U.S. Patent Serial No.:	09/737,697
Filing Date:	December 14, 2000
Examiner:	Sandra S. Snapp
Group No.:	2915
Title:	SOURCING SYSTEM AND METHOD

MAIL STOP APPEAL BRIEF - PATENT
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Corrected Appeal Brief

Appellants have appealed to the Board of Patent Appeals and Interferences ("Board") from the decision of the Examiner mailed January 12, 2005, finally rejecting all pending Claims 1-32. Appellants submitted an Appeal Brief for filing with the statutory fee of $500.00 on April 12, 2005.

Appellants submit this Corrected Appeal Brief to the Board of Patent Appeals and Interferences ("Board") in response to the Notification of the Examiner mailed July 27, 2005 requesting copies of the evidence submitted under 37 C.F.R. 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 C.F.R. § 41.37(c)(1)(ix)) and requesting copies of the decisions rendered by the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 C.F.R. § 41.37(c)(1)(x)).

Real Party In Interest

This Application is currently owned by UGS PLM Solutions Inc. as indicated by:

an Assignment recorded on January 31, 2000, from the inventors to A.T. Kearney, Inc., in the Assignment Records of the United States Patent and Trademark Office ("PTO") at Reel 010566, Frame 0203 (6 pages);

an Assignment recorded on December 12, 2000, from A.T. Kearney, Inc. to Ebreviate, Inc. C/O Electronic Data Systems Corporation, in the Assignment Records of the United States Patent and Trademark Office ("PTO") at Reel 011418, Frame 0201 (8 pages);

an Assignment recorded on February 4, 2004, from Electronic Data Systems Corporation to UGS PLM Solutions Inc., in the Assignment Records of the United States Patent and Trademark Office ("PTO") at Reel 014307, Frame 0325 (7 pages).

Related Appeals and Interferences

To the knowledge of Appellants' counsel, there are no known appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision regarding this Appeal.

Status of Claims

Claims 1-32 are pending in this Application, stand rejected pursuant to a final Office Action mailed January 12, 2005 (the "Final Office Action"), and are all presented for appeal. All pending claims are shown in Appendix A, attached hereto, along with an indication of the status of those claims.

Status of Amendments

All amendments submitted by Appellants have been entered by the Examiner.

Summary of Claimed Subject Matter

The present invention is useful in the context of a system for purchasing products or services using a multi-parameter auction, but is not limited to such applications. (Page 1, lines 9-12). Specifically, in certain embodiments, the present invention provides a method and apparatus for receiving multiple parameter bids on at least one product from a plurality of vendors. (Page 3, lines 3-5). A total cost of the product to the purchaser is calculated in response to each vendor's bid according to a total cost formula. (Page 3, lines 6-8). Accordingly, an entity may purchase products using an auction process that takes into account a variety of variables of interest to the purchaser other than price. (Page 3, lines 12-15).

In certain embodiments, as illustrated in FIGURES 1-5, a purchaser may begin the process of purchasing products (i.e., product systems, goods, supplies, equipment, services, or combinations thereof) by engaging a facilitator, auctioneer, or implementor of the system to assist the purchaser to purchase the products. (Page 9, lines 21-27). Alternatively, the implementor may be the purchaser itself. (Page 9, lines 27-28). The process may then include seven general steps, in particular embodiments. (Page 10, lines 2-4; FIGURE 1). The steps may include auction planning, the development of a request for information and/or a request for proposal, the issuance of a specification, the execution of an auction, final negotiations, the awarding of a contract, and the generation of a purchase order. (Page 10, lines 4-10). However, additional steps may be included or some or all of the seven steps may be excluded without departing from the scope of the invention. (Page 10, lines 10-23).

As part of the auction planning step, the implementor may identify several (preferably three to four) major cost drivers, as indicated by block 38 of FIGURE 2. (Page 12, lines 9-11). It should be appreciated that the number of major cost drivers could vary. (Page 12, lines 11-13). The major cost drivers may be used by the implementor to determine the comparable total cost for the products and generally include the base price plus applicable warranties, ancillary charges, discounts, rebates, and other charges or expenditures, which the system identifies as parameters. (Page 12, lines 13-18). Such parameters may include items for which a price is charged or other more subjective parameters. (Page 12, lines 18-20). Where parameters are subjective, the purchaser and/or implementor may quantify the

parameter and assign it a cost based upon the importance of the factor to the purchaser. (Page 12, lines 20-23). In addition, one or more formulas may be used to convert a parameter into a cost to be taken into account in a total cost formula. (Page 12, lines 23-25). For example, where a purchaser of equipment expects equipment to fail periodically, the mean time to failure for such equipment may be used to calculate the projected cost of the downtime for the equipment (such as, for example, where the downtime causes an assembly line to be halted). (Page 12, lines 25-30).

Thus, parameters may either be price or non-price parameters. (Page 12, lines 31-32). Examples of price parameters include: (i) base price; (ii) volume discounts; (iii) rebates; (iv) life cycle discounts; (v) utilization charges; (vi) maintenance charges; and (vii) administration charges. (Page 12, line 32 through Page 13, line 1). Examples of non-price parameters include: (i) delivery timing; (ii) national service coverage; (iii) quality levels; (iv) employee skill levels and training; (v) dedicated account management team resources; (vi) custom reporting services; (vii) online ordering; (viii) length of warranty; and (ix) length of contract. (Page 13, lines 1-7). In addition to variable parameters, the cost drivers may also include fixed values such as switching costs or other fixed costs of the supply relationship. (Page 13, lines 7-10).

Using the selected parameters and sub-categories, the implementor creates a total cost formula for each vendor. (Page 14, lines 4-5). The total cost formula may be the same for all participants in an auction or may be specific to each vendor. (Page 14, lines 6-7). The ability to use a formula specific to each vendor allows the software to take into account cost items specific to a particular vendor such as the cost of converting from one vendor to another. (Page 14, lines 7-11). As part of defining the formula, the implementor determines the unit labels and cost constant assigned to each of the parameters. (Page 14, lines 14-17). Thus, as defined herein, total cost is the costs to the purchaser for the products or category of products based on the selected parameters and sub-categories. (Page 14, lines 17-20).

In general, a plurality of vendors are identified for participation in the auction. (Page 15, line 5 through Page 16, line 5). The implementor or purchaser then sends an auction invitation to the listed vendors, as indicated by block 54 of FIGURE 3. (Page 16, lines 6-8).

In particular embodiments, the implementor may prepare the vendors for the auction by: (i) providing an auction help desk having a toll free number and email address; (ii) conducting a vendor information session; (iii) monitoring vendor participation in a practice auction; (iv) troubleshooting technical problems including calling vendors that do not submit bids in the practice auction; and (v) ensuring that the vendors understand the auction process. (Page 16, lines 24-31). Additionally, the purchaser or implementor may provide the vendors with the sub-category specifications and a bid sheet for conducting the auction. The bid sheet may include: (i) subcategories; (ii) parameters; (iii) product specifications; and (iv) minimum service requirements. (Page 17, lines 2-7). A vendor may then use a vendor accessible interface 128, such as the interfaces illustrated in FIGURES 25A and 25B, to participate in the auction. (Page 29, lines 20-23). This interface 128 enables the vendors to place bids on the various parameters for different sub-categories in each category. (Page 29, lines 23-25). The interface displays the vendor's current bid and enables the vendor to view the best bid submitted by another unidentified vendor for each of the parameters. (Page 29, lines 25-28).

As stated above, the implementor or purchaser then calculates a total cost of the product to the purchaser according to the total cost formula. (Page 3, lines 6-8). An activity viewing interface 126 accessible by the purchaser and implementor may be provided through an auction management interface 114. (Page 30, lines 23-26). Interface 126 displays specific information on a selected auction preferably including the total costs, savings, and savings percentage. (Page 30, lines 26-28). The system may also indicate the current best comparable total cost by displaying a low icon and a new bid by displaying a new icon. (Page 30, lines 32-34).

With regard to the independent claims currently under Appeal, Applicant provides the following concise explanation of the subject matter defined in the recited claim elements. Specifically, independent Claim 1 recites the following means plus function limitations as permitted by 35 U.S.C. § 112, paragraph 6:

> means for enabling each of a plurality of vendors to submit electronic vendor bids on at least two parameters associated with a product, the electronic vendor bids submitted over an electronic communications network (E.g., Original Claim 1; Figures 4, 5, 25A, 25B, and 37; page 17,

line 9 through page 18, line 3; page 29, line 19 through page 30, line 20; page 32, lines 11-19; and page 37, lines 9-29);

    means for calculating a total cost of the product to a purchaser for each vendor in response to the vendors bids, the total cost taking into account the at least two parameters associated with the product (E.g., Original Claim 1; Figures 4, 5, 10, 11, 16A, 16B, 17, 19A, 19B, and 37; page 17, line 9 through page 18, line 3; page 19, line 32 through page 20, line 19; page 23, line 8 through page 24, line 3; page 24, line 28 through page 25, line 16; page 32, lines 19-23; page 33, lines 1-34; and page 37, lines 9-29); and

    means for outputting each of the vendors bids and the total cost of the product to the purchaser (E.g., Original Claim 1; Figures 4, 5, 22A, 22B, 24, 26, 27, and 37; page 17, line 9 through page 18, line 3; page 26, line 27 through page 28, line 2; page 30, line 22 through page 31, line 25; page 32, lines 19-23; page 34, line 28 through page 35, line 17; and page 37, lines 9-29).

Dependent Claim 4 recites "means for communicating a vendor bid having the best total cost for the product to the vendors without revealing the identification of the vendor with the best total cost to encourage competitive bidding by other vendors." This is a means plus function recitation as permitted by 35 U.S.C. § 112, paragraph 6. The structure(s) and function described in the specification as corresponding to this "communicating" function may be found, for example, in Original Claim 4; Figures 25A, 25B, and 37; page 29, line 19 through page 30, line 20; page 37, lines 19-22.

Dependent Claim 5 recites "means for enabling the purchaser to make at least one adjustment corresponding to at least one of the vendor bids which is used by the calculating means to determine the total cost of the product to the purchaser." This is a means plus function recitation as permitted by 35 U.S.C. § 112, paragraph 6. The structure(s) and function described in the specification as corresponding to this "enabling" function may be found, for example, in Original Claim 5; Figures 26, 36 and 37; page 31, lines 1-10; page 32, lines 7-12; and page 37, lines 22-24.

Dependent Claim 8 recites that a "communication means enables messages to be sent to the vendors regarding the status of the bidding, ending time for the bidding and extensions of the bidding." This is a means plus function recitation as permitted by 35 U.S.C. § 112,

paragraph 6. The structure(s) and function described in the specification as corresponding to this "communicating" function may be found, for example, in Original Claim 8; Figures 25A, 25B, 36, and 37; page 28, lines 5-8; page 28, line 23 through page 29, line 17; page 29, line 30 through page 30, line 3; page 30, lines 12-20; page 33, lines 9-23; and page 37, lines 19-22.

Dependent Claim 9 recites "means for calculating an amount of savings for the purchaser and means for communicating the savings to the purchaser." This is a means plus function recitation as permitted by 35 U.S.C. § 112, paragraph 6. The structure(s) and function described in the specification as corresponding to this "communicating" function may be found, for example, in Original Claim 9; Figures 24, 28, 29, 30, 31; and page 30, line 22 through page 31, line 25.

Independent Claim 11 recites the following limitations:

a computer readable storage medium (E.g., Figures 36 and 37 and pages 33, lines 24-34);

software stored on the computer readable storage medium and operable to receive bids from a plurality of vendors, each bid comprising a plurality of parameters associated with at least one product, calculate the total cost of the at least one product to a purchaser for each vendor in response to the vendors' bids, the total cost taking into account the plurality of parameters associated with the at least one product, and output each of the vendors bids and the total cost of the product to the purchaser (E.g., Original Claim 11; Figures 4, 5, 10, 11, 16A, 16B, 17, 19A, 19B, 25A, 25B, 36, and 37; page 17, line 9 through page 18, line 3; page 19, line 32 through page 20, line 19; page 23, line 8 through page 24, line 3; page 24, line 28 through page 25, line 16; page 29, line 19 through page 30, line 20; page 32, lines 11-23; pages 33, lines 1-34; page 37, lines 9-29).

Independent Claim 25 recites the following limitations:

receiving bids from a plurality of vendors, each bid comprising a plurality of parameters associated with at least one product, calculating, using a computer, the total cost of the at least one product to a purchaser for each vendor in response to the vendors' bids, the total cost taking into account the plurality of parameters associated with the at least one product, and outputting, using the computer, each of the vendors bids and the total cost of the product to the purchaser (E.g., Original Claim 25; Figures 4, 5, 10, 11, 16A, 16B, 17, 19A, 19B, 25A, 25B, 36, and 37; page

17, line 9 through page 18, line 3; page 19, line 32 through page 20, line 19; page 23, line 8 through page 24, line 3; page 24, line 28 through page 25, line 16; page 29, line 19 through page 30, line 20; page 32, lines 11-23; pages 33, lines 1-34; page 37, lines 9-29).

Independent Claim 25 recites the following limitations:

receiving bids from a plurality of vendors, each bid comprising a plurality of parameters associated with at least one product, calculating, using a computer, the total cost of the at least one product to a purchaser for each vendor in response to the vendors' bids, the total cost taking into account the plurality of parameters associated with the at least one product, and outputting, using the computer, each of the vendors bids and the total cost of the product to the purchaser (E.g., Original Claim 25; Figures 4, 5, 10, 11, 16A, 16B, 17, 19A, 19B, 25A, 25B, 36, and 37; page 17, line 9 through page 18, line 3; page 19, line 32 through page 20, line 19; page 23, line 8 through page 24, line 3; page 24, line 28 through page 25, line 16; page 29, line 19 through page 30, line 20; page 32, lines 11-23; pages 33, lines 1-34; page 37, lines 9-29).

Grounds of Rejection to be Reviewed on Appeal

1.   Are Claims 1-3, 6-12, 14, and 16-32 patentable over U.S. Patent No. 6,397,197 issued to Gindlesperger ("*Gindlesperger*") under 35 U.S.C. § 102(b)?

2.   Are Claims 4-5, 13, and 15 patentable over the Examiner's proposed combination of *Gindlesperger* and U.S. Patent No. 3,573,747 issued to Adams et al. ("*Adams*") under 35 U.S.C. § 103(a)?

Grouping of Claims

Appellants have made an effort to group claims to reduce the burden on the Board. In the Argument section of this Appeal Brief, where appropriate, Appellants present arguments as to why particular claims subject to a ground of rejection are separately patentable from other claims subject to the same ground of rejection. To reduce the number of groups and thereby reduce the burden on the Board, Appellants do not argue individually every claim that recites patentable distinctions over the references cited by the Examiner, particularly in light of the clear allowability of Appellants' independent claims.

The claims of each group provided below may be deemed to stand or fall together for purposes of this Appeal:

1.   Group 1 may include independent Claims 1, 11, and 25 and dependent Claims 6-7, 10, 14, 18-20, 22-23, and 32;

2.   Group 2 may include: dependent Claims 2-3, which depend from Claim 1, Claims 16 and 24, which depend from Claim 11, and Claims 26-27, which depend from Claim 25;

3.   Group 3 may include dependent Claims 8 and 21, which depend from independent Claims 1 and 11, respectively;

4.   Group 4 may include dependent Claim 9, which depends from independent Claim 1, respectively.

5.   Group 5 may include dependent Claims 12 and 28-31, which depend from independent Claims 11 and 25, respectively;

6.   Group 6 may include dependent Claim 17, which depends from independent Claim 11;

7.   Group 7 may include dependent Claim 28, which depends from independent Claim 25;

8.   Group 8 may include dependent Claims 4 and 13, which depend from independent Claims 1 and 11, respectively; and

9.   Group 9 may include dependent Claims 5 and 15, which depend from independent Claims 1 and 11, respectively.

Argument

The rejection of Claims 1-3, 6-12, 14, and 16-32 under 35 U.S.C. § 102(b) as being anticipated by *Gindlesperger* is improper and should be reversed by the Board. The rejection of Claims 4-5, 13, and 15 under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Gindlesperger -Adams* combination is improper and should be reversed by the Board.

I. Claims 1-3, 6-12, 14, 16, 18-32 are Patentable over the *Gindlesperger* Reference.

A. Overview

Claims 1-3, 6-12, 14, 16, and 18-32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Gindlesperger*. A copy of *Gindlesperger* is provided in Appendix B. For the reasons discussed below, Appellants respectfully submit that Claims 1-3, 6-12, 14, 16, and 18-32 are patentable over *Gindlesperger*.

B. Standard

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he identical invention must be shown in as complete detail as contained in the . . . claim." M.P.E.P. § 2131 citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, "[t]he elements must be arranged as required by the claim." *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131.

C. The *Gindlesperger* Reference

Gindlesperger discloses an apparatus and method for creating a database representing print and other information product vendor pools for one or more subscribing buyers, and for selecting the lowest bidder from the database's represented vendor pool on a per-job basis. (Column 1, lines 9-15). Accordingly, the *Gindlesperger* system maintains "a database of vendor records, each record identifying a vendor, one or more buyers who approves the vendor for receipt of invitations to bid, and a vendor capability data representing production and economic capabilities of the vendor." (Abstract). Thus, at the onset, the buyer identifies

a list of vendors who the buyer is willing to purchase a product or service from at any given time, and this list is stored in the database.

When a buyer wishes to receive bids on a product, the buyer sends an invitation-for-bid describing the product or service that the buyer wishes to procure. (Column 5, lines 2-4). The server system "extract[s] a vendor selection criteria data from the buyer's invitation-for-bid." (Column 5, lines 5-6). The vendor selection criteria "[defines] the values that a vendor's capability data must meet to qualify for, and to receive, a vendor's invitation-for-bid." (Column 5, lines 6-10). The *Gindlesperger* server then "compares and correlates the vendor selection criteria data [contained in the invitation] to the vendor capability data field of each vendor data record in the buyer's vendor pool database." (Column 5, lines 11-14). Thus, the buyer's criteria is compared against the capabilities of each vendor (as stored in the database) and the pool of eligible vendors is narrowed.

Upon identifying qualifying vendors, the *Gindlesperger* server "transmits a vendor's invitation-for-bid data to each vendor in the buyer's vendor pool whose vendor capability data field meets the vendor selection criteria data extracted from the buyer's invitation-for-bid data." (Column 5, lines 14-18). As such, invitations-for-bids are sent only to those vendors who met the buyer's criteria, as discussed above. The vendor's invitation-for-bid "requests a bid response corresponding to the buyer's invitation-for-bid" from any of the qualifying vendors. (Column 5, lines 6-10). Additionally, the vendor's invitation for bid "specifies the print information product or service in a consistent, standardized format so that each receiving vendor will understand clearly all product, delivery and other requirements for the print information item or service that is being placed out for bids by the buyer." (Column 7, lines 60-65). "This arrangement ensures that the bids are comparable and that mistakes as to the requirements of the buyer are minimized, while enabling each vendor to prepare a more precise calculation of its responding bid." (Column 7, line 65 through Column 8, line 2).

In response the vendor's invitations-for-bid, the *Gindlesperger* server receives bids from the qualified and invited vendors. (Column 5, lines 18-22). Each bid represents "the transmitting vendor's price for the particular print information goods or services requested." (Column 5, lines 22-24). The *Gindlesperger* server "then selects the responding bid data

having the lowest represented vendor price and generates information identifying the buyer of the identity of the selected vendor." (Column 5, lines 24-27). Upon the buyer's approval of the selected vendor, the *Gindlesperger* server "issues an order to the selected vendor for the purchase of the at least one printed item." (Column 5, lines 28-30). The server also "transmits to the remaining non-selected vendors in the vendor pool a bidding result data representing the identity of the selected vendor, and the rank order value of the bid data submitted by all other selection pool vendors." (Column 5, lines 30-35).

In the manner described, "the print buyer sets the parameters for both vendor pool selection and for the bidding and award process." (Column 9, lines 46-48). "The parameters are set in such a way, however, that vendor quality and responsibility is determined at the time each vendor pool is established and only the responsiveness of each vendor's bid is reviewed at the time of the award." (Column 9, lines 48-52). As a result, only the vendor price in the vendor's bid is considered, and the award is given to the vendor having the "lowest represented vendor price." (Column 5, lines 24-27). "Moreover, the bidding and award process is standardized so as to make the dissemination of invitations for bid, the receipt of bids, and the award of the job to the lowest responsive and responsible bidder virtually automatic and without the need for additional procurement staff or the expenditure of related out-of-pocket administrative costs." (Column 9, lines 55-60). "In addition, knowing beforehand that the award will go the lowest responsive and responsible bidder, each participating vendor will have an incentive to submit their lowest bid upfront, rather than hold back their lowest bid, as they would otherwise be inclined to do if the award was still going to be negotiated after bid opening." (Column 10, lines 3-8).

D.   Group 1 (Claims 1, 6-7, 10-11, 14, 18-20, 22- 23, 25, and 32)

Claims 1, 6-7, 10-11, 14, 18-20, 22-23, 25, and 32 stand rejected under 35 U.S.C. §

102(b) as being anticipated by *Gindlesperger*. Appellants respectfully submit, however, that

the *Gindlesperger* reference does not disclose, teach, or suggest each and every element

recited in Appellants' Claims 1, 6-7, 10-11, 14, 18-20, 22-23, 25, and 32.

For example, independent Claim 1, as amended, recites an electronic bidding system

that includes:

> means for enabling each of a plurality of vendors to submit
> electronic vendor bids on at least two parameters associated with a
> product, the electronic vendor bids submitted over an electronic
> communications network;
>   means for calculating a total cost of the product to a
> purchaser for each vendor in response to the vendors bids, the total
> cost taking into account the at least two parameters associated with
> the product; and
>   means for outputting each of the vendors bids and the total
> cost of the product to the purchaser.

Thus, Claim 1 recites an electronic bidding system that receives vendor bids having "at least

two parameters associated with a product." A "total cost" is then calculated that "[takes] into

account the at least two parameters associated with the product." Finally, the "total cost of

the product" is output to the purchaser.

In the Office Action, the Examiner relies on *Gindlesperger* for disclosure of each and

every element of Appellants' Claim 1. Appellants' respectfully submit, however, that

Gindlesperger does not disclose, teach, or suggest a "means for enabling each of a plurality

of vendors to submit electronic vendor bids on at least two parameters associated with a

product," as recited in Appellants' Claim 1. As discussed above, the *Gindlesperger* system

maintains "a database of vendor records, each record identifying a vendor, one or more

buyers who approves the vendor for receipt of invitations to bid, and a vendor capability data

representing production and economic capabilities of the vendor." (Abstract). Thus, the

buyer identifies a list of vendors who the buyer is willing to purchase a product or service

from at any given time, and this list is stored in the database prior to the bidding process.

When a buyer wishes to receive bids on a product, the buyer sends an invitation-for-bid

describing the product or service that the buyer wishes to procure. (Column 5, lines 2-4).

The server system then "extract[s] a vendor selection criteria data from the buyer's invitation-for-bid" to identify vendors qualified to bid. (Column 5, lines 5-6). Specifically, the *Gindlesperger* server "compares and correlates the vendor selection criteria data [contained in the invitation] to the vendor capability data field of each vendor data record in the buyer's vendor pool database." (Column 5, lines 11-14). Thus, the buyer's criteria is compared against the capabilities of each vendor (as stored in the database) and the pool of eligible vendors is narrowed before bids are received.

The *Gindlesperger* server then "transmits a vendor's invitation-for-bid data to each vendor in the buyer's vendor pool whose vendor capability data field meets the vendor selection criteria data extracted from the buyer's invitation-for-bid data." (Column 5, lines 14-18). As such, invitations-for-bids are sent only to those vendors who have been predetermined to meet the buyer's criteria. Next, the *Gindlesperger* server receives bids from the invited vendors. (Column 5, lines 18-22). A vendor bid "represents the transmitting vendor's price for the particular . . . goods or services requested." (Column 5, lines 22-24). Because the resulting vendor bid includes only the vendor's price, Appellants respectfully submit that there is no disclosure in *Gindlesperger* that the vendors submit bids "on at least two parameters associated with a product," as recited in Appellants' Claim 1. In fact, and as described above, *Gindlesperger* discloses that "by employing the invention, the print *buyer sets the parameters* for both vendor pool selection and for the bidding and award process." (Column 9, lines 46-48). As a result, only the vendor price in the vendor's bid is considered, and the award is given to the vendor having the "lowest represented vendor price." (Column 5, lines 24-27). Thus, a bid submitted by a vendor does not include any parameter beyond the vendor's price. Accordingly, Appellants respectfully submit that *Gindlesperger* does not disclose, teach, or suggest a "means for enabling each of a plurality of vendors to submit electronic vendor bids on at least two parameters associated with a product," as recited in Appellants' Claim 1.

As a further example of the deficiencies of *Gindlesperger*, Appellants respectfully submit that *Gindlesperger* does not disclose, teach, or suggest a "means for calculating a total cost of the product to a purchaser for each vendor in response to the vendors bids, the total cost taking into account the at least two parameters associated with the product," as recited in

Appellants' Claim 1. As described above, the *Gindlesperger* server merely receives each vendor bid, which "represent[s] the transmitting vendor's price for the particular . . . goods or services requested." (Column 5, lines 22-24). Upon receiving bids from the plurality of vendors "to whom a vendor invitation-for-bid data was transmitted," the *Gindlesperger* server "then selects the responding bid data having the lowest represented vendor price and generates information identifying the buyer of the identity of the selected vendor." (Column 5, lines 21-27.) Thus, the *Gindlesperger* server merely considers the vendor prices submitted in the plurality of bids, picks the lowest, and transmits the identity of the lowest bidder to the buyer. By disclosing that the vendor bids are awarded to the bid having the lowest represented vendor price, *Gindlesperger* certainly cannot be said to disclose, teach, or suggest a "means for calculating a total cost of the product to a purchaser for each vendor in response to the vendors bids, the total cost taking into account the at least two parameters associated with the product," as recited in Appellants' Claim 1.

The Examiner also relies on *Gindlesperger* to reject independent Claims 11 and 25. Appellants respectfully submit that *Gindlesperger* does not disclose, teach, or suggest each and every element of Appellants' independent Claims 11 and 25. For example, Claim 11 recites "software stored on the computer readable storage medium and operable to receive bids from a plurality of vendors, each bid comprising a plurality of parameters associated with at least one product, calculate the total cost of the at least one product to a purchaser for each vendor in response to the vendors' bids, the total cost taking into account the plurality of parameters associated with the at least one product, and output each of the vendors bids and the total cost of the product to the purchaser." Claim 25 recites "receiving bids from a plurality of vendors, each bid comprising a plurality of parameters associated with at least one product, calculating, using a computer, the total cost of the at least one product to a purchaser for each vendor in response to the vendors' bids, the total cost taking into account the plurality of parameters associated with the at least one product, and outputting, using the computer, each of the vendors bids and the total cost of the product to the purchaser." Thus, for reasons similar to those discussed above with regard to Claim 1, Appellants respectfully submit that *Gindlesperger* does not disclose, teach, or suggest each and every element as set forth in Appellants' independent Claims 11 and 25.

For at least these reasons, the *Gindlesperger* reference is clearly insufficient to support the Examiner's rejection of independent Claims 1, 11, and 25 under 35 U.S.C. § 102(b). These claims are therefore patentable over the *Gindlesperger* reference. Claims 6-7 and 10 depend directly or indirectly from Claim 1. Claims 14, 18-20, and 22-23 depend directly or indirectly upon Claim 11. Claim 32 depends directly or indirectly upon Claim 25. Thus, for the same reasons that independent Claims 1, 11, and 25 are allowable, these dependent claims are also allowable. Appellants respectfully submit that these rejections are improper and should be reversed by the Board.

E.   Group 2 (Claims 2-3, 16, 24, and 26-27)

Claims 2-3, 16, 24, and 26-27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the *Gindlesperger* reference. Because the claims are clearly patentable over the *Gindlesperger* reference, Appellants respectfully submit that the rejections of Claims 2-3, 16, 24, and 26-27 are improper and should be reversed by the Board.

Claims 2-3, depend from independent Claim 1, which Appellants have shown above to be clearly patentable over the *Gindlesperger* reference. Dependent Claims 16 and 24 depend from independent Claim 11, which Appellants have shown above to be clearly patentable over the *Gindlesperger* reference. Dependent Claims 26-27 depend from independent Claim 25, which Appellants have shown above to be clearly patentable over the *Gindlesperger* reference. Accordingly, because dependent Claims 2-3, 16, 24, and 26-27 incorporate the limitations of their respective independent claims, Appellants respectfully submit that dependent Claims 2-3, 16, 24, and 26-27 are allowable and that the rejection of the claims should be reversed.

Additionally, Claims 2-3, 16, 24, and 26-27 are separately patentable from every other claim subject to the same ground of rejection. The claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, Claims 2-3, 16, 24, and 26-27 recite patentable distinctions over the prior art beyond those recited in independent Claims 1, 11, and 25. Specifically, Appellants respectfully submit that *Gindlesperger* does not disclose, teach, or suggest in any manner:

- that the bids "include a plurality of parameters for the product and the total cost calculating means determines the total cost of the product to the purchaser using a pre-determined total cost formula," as recited in Claim 2;

- that "the total cost formula includes at least one pre-defined constant," as recited in Claim 3 and similarly recited in Claim 27;

- that "the total cost calculated for each vendor uses a single formula for all vendors," as recited in Claim 16;

- that the total cost formula is "defined for each product in an auction," as recited in Claim 24; and

- that the total cost formula is "defined for the category of products in response to the plurality of parameters, as recited in Claim 26.

With respect to the above recited Claim limitations, the Examiner has identified the following portion of *Gindlesperger* as anticipating Appellants' claims:

> The vendor's invitation for bid VIFB specifies the print information product or service in a consistent, standardized format so that each receiving vendor will understand clearly all product, delivery and other requirements for the print information item or service that is being placed out for bids by the buyer. This arrangement ensures that the bids are comparable and that mistakes as to the requirements of the buyer are minimized, while enabling each vendor to prepare a more precise calculation of its responding bid.

(Column 7, line 60 through Column 8, line 2; Final Office Action, Pages 3-6). The Examiner's reliance on this portion of *Gindlesperger*, however, seems to ignore the very fact that *Gindlesperger* specifically discloses that it is the vendor's invitation for bid that specifies the requirements of the buyer. As stated above, the *Gindlesperger* system sends invitations-for-bids only to those vendors who have been predetermined to meet the buyer's criteria. Accordingly, "the print *buyer sets the parameters* for both vendor pool selection and for the bidding and award process." (Column 9, lines 46-48). Because only those vendors who have been predetermined to meet the buyer's criteria are invited to place bids, only the vendor price in the vendor's bid is considered, and the award is given to the vendor having the lowest represented vendor price. (Column 5, lines 24-27). Accordingly, there is no calculation of a

"total cost" with respect to each vendor's bid. Certainly, there is no calculation of a "total cost" that incorporates the various features described in Claims 2-3, 16, 24, and 26-27.

For at least these reasons, the *Gindlesperger* reference fails to support the anticipation rejection of dependent Claims 2-3, 16, 24, and 26-27. The claims are therefore patentable over the *Gindlesperger* reference. Appellants respectfully submit that the rejections of Claims 2-3, 16, 24, and 26-27 are improper and should be reversed by the Board.

F.   Group 3 (Claims 8 and 21)

Claims 8 and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the *Gindlesperger* reference. Because the claims are clearly patentable over the *Gindlesperger* reference, Appellants respectfully submit that the rejections of Claims 8 and 21 are improper and should be reversed by the Board.

Claims 8 and 21, depend from independent Claims 1 and 11, respectively, which Appellants have shown above to be clearly patentable over the *Gindlesperger* reference. Accordingly, because dependent Claims 8 and 21 incorporate the limitations of their respective independent claims, Appellants respectfully submit that dependent Claims 8 and 21 are allowable and that the rejection of the claims should be reversed.

Additionally, Claims 8 and 21 are separately patentable from every other claim subject to the same ground of rejection. The claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, Claims 8 and 21 recite patentable distinctions over the prior art beyond those recited in independent Claims 1 and 11 (from which Claims 8 and 21 depend, respectively). Specifically, Claim 8 recites a communication means enabling " messages to be sent to the vendors regarding the status of bidding, ending time for the bidding, and extensions of the bidding." Claim 21 recites that the software is further operable to "provide a vendor with data about the status of an auction while the auction is in progress."

With respect to Claims 8 and 21, the Examiner has identified the following portion of *Gindlesperger* as disclosing the claimed features:

> Upon the PrintProSys^{SM} server's receipt of an approval data from the buyer, it issues an order to the selected vendor for the purchase of the at least one printed item. In addition, the PrintProSys^{SM} [server] transmits to the remaining non-selected vendors in the vendor pool a bidding result data representing the identity of the selected vendor, and the rank order value of the bid data submitted by all other selection pool vendors.

(Column 5, lines 28-35; Final Office Action, Pages 3-5). The communications discussed in the cited portion, however, are clearly transmitted after the selection of "the responding bid data having the lowest represented vendor price" and after "approval data" is received from the buyer. (Column 5, lines 24-30). Thus, the bidding process is complete when the communications are transmitted to and received by the non-winning vendors. Accordingly, *Gindlesperger* does not disclose, teach, or suggest the various features recited in Appellants' Claims 8 and 21.

For at least these reasons, the *Gindlesperger* reference fails to support the anticipation rejection of dependent Claims 8 and 21. The claims are therefore patentable over the *Gindlesperger* reference. Appellants respectfully submit that the rejections of Claims 8 and 21 are improper and should be reversed by the Board.

G. Group 4 (Claim 9)

Claim 9 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the *Gindlesperger* reference. Because Claim 9 is clearly patentable over the *Gindlesperger* reference, Appellants respectfully submit that the rejection of Claim 9 is improper and should be reversed by the Board.

Claim 9 depends from independent Claim 11, which Appellants have shown above to be clearly patentable over the *Gindlesperger* reference. Accordingly, because dependent Claim 9 incorporates the limitations of Claim 11, Appellants respectfully submit that dependent Claim 9 is allowable and that the rejection of the claim should be reversed.

Additionally, Claim 9 is separately patentable from every other claim subject to the same ground of rejection. Claim 9 recites limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, Claim 9 recites patentable distinctions over the prior art beyond those recited in independent Claim 11 (from which Claim 9 depends). Specifically, Claim 9 recites "means for calculating an amount of savings for the purchaser and means for communicating the savings to the purchaser." With respect to Claim 9, the Examiner has identified the following portion of *Gindlesperger* as disclosing the recited features:

> A main reason is that gathering and maintaining information about a large number of current and potential print vendors is time consuming and expensive. Few companies have the time, money, or inclination to maintain a large, up-to-date database on such potential vendors, particularly when soliciting dozens of bids or quotations will itself require staff and administrative time that costs more than the savings generated from competitive bidding. This disparity is heightened by the fact that most print jobs involve relatively low dollar purchases or procurements.

(Column 3, lines 30-37; Final Office Action, Page 4). The cited portion of *Gindlesperger*, however, merely identifies the need for "a large vendor pool to obtain the benefit of enhanced pricing competition, without imposing relatively high administrative costs or causing a loss of quality control." (Column 4, lines 38-43). The quoted portion does not any way disclose, teach, or suggest a "means for calculating an amount of savings for the purchaser and means for communicating the savings to the purchaser," as recited in Claim 9. Furthermore, and as discussed above in more detail, the *Gindlesperger* system discloses only that, in response to receiving "a plurality of responding bid data, each being from a corresponding one of the plurality of vendors . . . and each representing the transmitting vendor's price for the particular . . . goods or services requested," the server "selects the responding bid data having the lowest represented vendor price." (Column 5, lines 18-25). The selected vendor is then identified to the buyer. (Column 5, lines 25-27). Accordingly, their is no disclosure in *Gindlesperger* of a "means for calculating an amount of savings for the purchaser and means for communicating the savings to the purchaser," as recited in Claim 9.

For at least these reasons, the *Gindlesperger* reference fails to support the anticipation rejection of dependent Claim 9. Claim 9 is therefore patentable over the *Gindlesperger* reference. Appellants respectfully submit that these rejections are improper and should be reversed by the Board.

H.   Group 5 (Claims 12 and 29-31)

Claims 12 and 29-31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the *Gindlesperger* reference. Because the claims are clearly patentable over the *Gindlesperger* reference, Appellants respectfully submit that the rejections of Claims 12 and 29-31 are improper and should be reversed by the Board.

Claims 12 and 29-31, depend from independent Claims 11 and 25, respectively, which Appellants have shown above to be clearly patentable over the *Gindlesperger* reference. Accordingly, because dependent Claims 12 and 29-31 incorporate the limitations of their respective independent claims, Appellants respectfully submit that dependent Claims 12 and 29-31 are allowable and that the rejection of the claims should be reversed.

Additionally, Claims 12 and 29-31 are separately patentable from every other claim subject to the same ground of rejection. These claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, Claims 12 and 29-31 recite patentable distinctions over the prior art beyond those recited in independent Claims 11 and 25 (from which Claims 12 and 29-31 depend, respectively). Specifically, Claim 12 recites that "the at least two parameters are selected from a group consisting of price, discount, delivery, installation, training, maintenance, the risks covered by warranty, and length of warranty." Claim 31 recites "defining at least two sub-categories for the category of products, and defining at least two parameters for each subcategory."

With respect to the above recited Claim limitations, the Examiner has identified a portion of the background section of *Gindlesperger*, which discloses factors that may effect price elasticity. (Column 2, lines 24-36; Final Office Action, pages 4-6). Although *Gindlesperger* discloses that these factors may include the level of service and quality desired, the labor and equipment required, the amount of time involved, engineering

considerations, and delivery date, Appellants submit that the Examiner is again ignoring that the *Gindlesperger* system specifically requires that "the print *buyer sets the parameters* for both vendor pool selection and for the bidding and award process." (Column 9, lines 46-48). Accordingly, resulting vendor bids are not submitted on multiple parameters. Instead, the vendor bids merely "represent the transmitting vendor's price for the particular . . . goods or services requested." (Column 5, lines 22-24) Accordingly, the vendor bids do not incorporate the various features described in Claims 12 and 29-31.

For at least these reasons, the *Gindlesperger* reference fails to support the anticipation rejection of dependent Claims 12 and 29-31. The claims are therefore patentable over the *Gindlesperger* reference. Appellants respectfully submit that the rejections of Claims 12 and 29-31 are improper and should be reversed by the Board.

I.   Group 6 (Claim 17)

Claim 17 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the *Gindlesperger* reference. Because Claim 17 is clearly patentable over the *Gindlesperger* reference, Appellants respectfully submit that the rejections of Claim 17 is improper and should be reversed by the Board.

Claim 17 depends from independent Claim 11, which Appellants have shown above to be clearly patentable over the *Gindlesperger* reference. Accordingly, because dependent Claim 17 incorporates the limitations of independent Claim 11, Appellants respectfully submit that dependent Claim 17 is allowable and that the rejection of the claim should be reversed.

Additionally, Claim 17 is separately patentable from every other claim subject to the same ground of rejection. The claim recites limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, Claim 17 recites patentable distinctions over the prior art beyond those recited in independent Claim 11. Specifically, Appellants respectfully submit that *Gindlesperger* does not disclose, teach, or suggest in any

manner that "the total cost calculated for each vendor uses a plurality of formulas, each vendor having one of the plurality of formulas associated with it," as recited in Claim 17.

With respect to the above recited Claim limitations, the Examiner has identified the following portion of *Gindlesperger* as anticipating Appellants' claims:

> The vendor's invitation for bid VIFB specifies the print information product or service in a consistent, standardized format so that each receiving vendor will understand clearly all product, delivery and other requirements for the print information item or service that is being placed out for bids by the buyer. This arrangement ensures that the bids are comparable and that mistakes as to the requirements of the buyer are minimized, while enabling each vendor to prepare a more precise calculation of its responding bid.

(Column 7, line 60 through Column 8, line 2; Final Office Action, Pages 3-6). The Examiner's reliance on this portion of *Gindlesperger*, however, seems to ignore the very fact that *Gindlesperger* specifically discloses that it is the vendor's invitation for bid that specifies the requirements of the buyer. As stated above, the *Gindlesperger* system sends invitations-for-bids only to those vendors who have been predetermined to meet the buyer's criteria. Accordingly, "the print *buyer sets the parameters* for both vendor pool selection and for the bidding and award process." (Column 9, lines 46-48). Because only those vendors who have been predetermined to meet the buyer's criteria are invited to place bids, only the vendor price in the vendor's bid is considered, and the award is given to the vendor having the lowest represented vendor price. (Column 5, lines 24-27). In fact, *Gindlesperger* makes clear that the system merely inputs responding bids into the database and ranks them in order of price. (Abstract). Accordingly, there is no calculation of a "total cost for each vendor [using] a plurality of formulas, each vendor having one of the plurality of formulas associated with it," described in Claim 17. By using a particular formula specified for a vendor, Applicants' claim takes into account that different vendors have different costs. (Applicants Specification, page 14, lines 7-11). This feature is completely absent from the teachings of *Gindlesperger*.

For at least these reasons, the *Gindlesperger* reference fails to support the anticipation rejection of dependent Claim 17. Claim 17 is therefore patentable over the *Gindlesperger*

reference. Appellants respectfully submit that the rejection of Claim 17 is improper and should be reversed by the Board.

J.   Group 7 (Claim 28)

Claim 28 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the *Gindlesperger* reference. Because Claim 28 is clearly patentable over the *Gindlesperger* reference, Appellants respectfully submit that the rejections of Claim 28 is improper and should be reversed by the Board.

Claim 28 depends from independent Claim 25, which Appellants have shown above to be clearly patentable over the *Gindlesperger* reference. Accordingly, because dependent Claim 28 incorporates the limitations of independent Claim 25, Appellants respectfully submit that dependent Claim 28 is allowable and that the rejection of the claim should be reversed.

Additionally, Claim 28 is separately patentable from every other claim subject to the same ground of rejection. The claim recites limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, Claim 28 recites patentable distinctions over the prior art beyond those recited in independent Claim 25 (from which Claim 28 depends). Specifically, Claim 28 recites that "the plurality of parameters includes price and non-price parameters."

With respect to the above recited claim limitations, the Examiner has identified a portion of the background section of *Gindlesperger*, which discloses factors that may effect price elasticity. (Column 2, lines 24-36; Final Office Action, pages 4-6). Although *Gindlesperger* discloses that these factors may include the level of service and quality desired, the labor and equipment required, the amount of time involved, engineering considerations, and delivery date, Appellants submit that the Examiner is again ignoring that the *Gindlesperger* system specifically requires that "the print *buyer sets the parameters* for both vendor pool selection and for the bidding and award process." (Column 9, lines 46-48). Accordingly, resulting vendor bids are not submitted on multiple parameters. Instead, the

vendor bids merely "represent the transmitting vendor's price for the particular . . . goods or services requested."   (Column 5, lines 22-24)   Accordingly, the vendor bids of *Gindlesperger* do not incorporate "non-price parameters," as recited in Claim 28, which are then taken into account in calculating a "total cost," as recited in independent Claim 25 and incorporated into Claim 28 by its dependency on Claim 25.

For at least these reasons, the *Gindlesperger* reference fails to support the anticipation rejection of dependent Claim 28. Claim 28 is therefore patentable over the *Gindlesperger* reference. Appellants respectfully submit that the rejection of Claim 28 is improper and should be reversed by the Board.

II.   Claims 4-5, 13, and 15 are Clearly Patentable over the proposed *Gindlesperger-Adams* Combination.

A.   *Overview*

Claims 4-5, 13, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gindlesperger* in view of *Adams*. A copy of *Adams* is provided in Appendix C. Appellants respectfully submit that the proposed *Gindlesperger-Adams* combination fails to disclose, teach, or suggest limitations recited in Appellants' claims. Appellants further submit that even if the references did not fail to disclose, teach, or suggest each and every limitation recited in Appellants' claims, the *Gindlesperger-Adams* combination would still be improper because the Examiner has not provided a sufficient teaching, suggestion, or motivation in the prior art to make the proposed combination. Still further, Appellants respectfully submit that the Examiner has used improper hindsight reconstruction to make the proposed *Gindlesperger-Adams* combination, which the M.P.E.P. and the governing Federal Circuit case law clearly prohibit. Accordingly, Appellants respectfully submit that the rejections of claims 4-5, 13, and 15 are improper and should be reversed by the Board.

B.   *Standard*

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. *See* 35 U.S.C. § 103(a). Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill in the art at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference

teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an Appellant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.[1] According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention

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[1] Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an Appellant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

C. *The Adams Reference*

Adams discloses an apparatus and method for "automatically, anonymously and equitably buying and selling fungible properties between subscribers." (Column 1, lines 43-46). Accordingly, "a communication system is provided in which institutional investors communicate automatically, anonymously and equitably with each other for the purpose of trading securities." (Column 1, lines 67-70). "Said system comprises a centralized data storage unit, a digital computer, a plurality of subscriber terminals and a plurality of communication links established therebetween." (Abstract). "The method of the system comprises the steps of:

- booking unfilled buy offers including associated price and quantity parameters on a buy offer list in a priority sequence according to a first predetermined program;
- booking unfilled sell offers including associated price and quantity parameters on a sell offer list in a priority sequence according to a second predetermined program;
- comparing in said priority sequence, the price and quantity parameters of each incoming offer with the corresponding parameters of each offer on the complementary one of said lists'
- transacting said received offer with the higher priority offers on said complementary list if said incoming offer can be matched against one or more offers on the complementary offer list; and
- placing the untransacted portion of said received offer on the corresponding one of said lists in a priority sequence according to the corresponding one of said predetermined programs if said incoming offer cannot be completely matched against offers on complementary offer list.

(Abstract).

In a particular example, "[w]hen the originator of an offer enters into a negotiation with another subscriber, the preferred embodiment of this invention protects that offer by

placing it in a hold status. (Column 10, lines 37-39). "This ensures that the original offer can not be transacted by a third subscribed during the negotiation between the original two subscribers. (Column 10, lines 39-42). "The originator of the original offer may remove the hold immediately if he wishes the offer to remain active throughout his negotiations." (Column 10, lines 42-44). "If the negotiations result in a closing (i.e., some part or all of the original offer has been accepted by a reply or a subsequent reply by one of the subscribers has been accepted in part or totally by the other subscriber) the offer is altered in one of two ways. " (Column 10, lines 44-48). "If the quantity bought or sold is equal to the quantity of the original offer, the offer is removed from the books." (Column 10, lines 48-50). If the quantity transacted is less than the quantity of the original offer, the offer is kept in the book and adjusted to reflect the remaining quantity." (Column 10, lines 50-52).

D.   *Even when combined, the references clearly fail to disclose, teach, or suggest limitations recited in the claims*

Appellants respectfully submit that Claims 4-5, 13, and 15 are clearly patentable over the proposed *Gindlesperger-Adams* combination because the neither reference nor their proposed combination discloses, teaches, or suggests the combination of features recited in Appellants' Claims 4-5, 13, and 15.

1.   Group 8 (Claims 4 and 13)

Appellants respectfully submit that the proposed *Gindlesperger-Adams* combination does not disclose, teach, or suggest each and every element recited in Appellants' Claims 4 and 13. The claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, Claims 4 and 13 recite patentable distinctions over the prior art beyond those recited in independent Claims 1 and 11 (from which Claims 4 and 13 depend, respectively).

Specifically, Claim 4 recites "means for communicating a vendor bid having the best total cost for the product to the vendors without revealing the identification of the vendor with the best total cost to encourage competitive bidding by the other vendors." Claim 13 recites that the software is further operable to "send data, comprising a vendor bid having the

best total cost for the product, to the vendors during the auction without revealing the identification of the vendor with the best total cost." In the Final Office Action, the Examiner acknowledges that *Gindlesperger* does not disclose, teach, or suggest the above-recited features. Rather, the Examiner relies upon *Adams* for disclosure of the features recited in Claims 4 and 13. (Final Office Action, page 8).

As discussed above, *Adams* merely discloses "comparing the price and quantity parameters of each incoming offer with the corresponding parameters of each offer on the complementary one of said lists" in a search for a match. (Abstract). Thus, a transaction is completed where a match is found. With respect to offers that are partially matched, *Adams* discloses "placing the untransacted portion of [the matched] offer on the corresponding one of said lists in a priority sequence." (Abstract.) Accordingly, any untransacted portion of an offer that remains after a match is made is placed back on the offer list so that a future match may be made. There is no disclosure, however, that the *Adams* system communicates "vendor bid having the best total cost for the product to the vendors . . . to encourage competitive bidding by the other vendors," as recited in Claim 4 and as suggested by the Examiner. Similarly, there is no disclosure in *Adams* that data, "comprising a vendor bid having the best total cost for the product," is sent to the vendors during the auction, as recited in Claim 13.

Furthermore, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); M.P.E.P. § 2141.02. Appellants respectfully submit that, for different reasons, both *Gindlesperger* and *Adams* actually teach away from a system that "encourages competitive bidding" between the vendors. Specifically, *Gindlesperger* discloses that an objective of the of the bidding system of *Gindlesperger* is that "each participating vendor will have an incentive to submit their lowest bid upfront, rather than hold back their lowest bid, as they would be inclined to do if the award was still going to be negotiated after bid opening." (Column 10, lines 3-8). This incentive stems from the fact that the vendors "[know] beforehand that the award will go to the lowest responsive and responsible bidder." (Column 10, lines 3-5). Thus, each vendor of the *Gindlesperger*

system submits only one bid to be considered in determining the award. The bidding process of *Gindlesperger* is competitive only in the fact that a vendor's one bid is compared against every other vendor's one bid. The teachings of *Adams* are similarly contrary to a competitive bidding atmosphere. Specifically, *Adams* discloses that "[w]hen the originator of an offer enters into a negotiation with another subscriber, the preferred of this invention protects that offer by placing it in a hold status." (Column 10, lines 37-39). "This ensures that the original offer can not be transacted by a third subscriber during the negotiation between the original two subscribers." (Column 10, lines 39-42). Because *Gindlesperger* discloses that each vendor has only one opportunity to submit a bid and *Adams* discloses that an offer is placed on hold during the negotiation process, both *Gindlesperger* and *Adams* teach away from the features and operations recited in Claims 4 and 13.

For at least these reasons, Appellants submit that neither *Gindlesperger*, *Adams*, nor their combination disclose, teach, or suggest the features recited in Claims 4 and 13. Accordingly, Appellants respectfully submit that the rejections of Claims 4 and 13 are improper and should be reversed by the Board.

2.   Group 9 (Claims 5 and 15)

Appellants respectfully submit that the proposed *Gindlesperger-Adams* combination also does not disclose, teach, or suggest each and every element recited in Appellants' Claims 5 and 15. The claims recite limitations that are substantially different from limitations recited in the claims of other groups and cannot be properly grouped with the claims of other groups for purposes of this Appeal. For example, Claims 5 and 15 recite patentable distinctions over the prior art beyond those recited in independent Claims 1 and 11 (from which Claims 5 and 15 depend, respectively).

Specifically, Claim 5 recites "means for enabling the purchaser to make at least one adjustment corresponding to at least one of the vendor bids which is used by the calculating means to determine the total cost of the product to the purchaser." Claim 15 recites that the software is further operable to "enable the purchaser to make at least one adjustment corresponding to at least one vendor bid which is used by the central auction management system to calculate the total cost of the product to the purchaser." In the Final Office Action,

the Examiner acknowledges that *Gindlesperger* does not disclose, teach, or suggest the above-recited features. Rather, the Examiner relies upon *Adams* for disclosure of the features recited in Claims 5 and 15. (Final Office Action, Page 8).

As discussed above, *Adams* merely discloses that an offered may be "altered in one of two ways." (Column 10, lines 44-48). In a first scenario, the *Adams* system may alter an offer "[i]f the quantity bought or sold is equal to the quantity of the original offer." (Column 10, lines 48-50). Specifically, "the offer is removed from the books." (Column 10, lines 48-50). Thus, if the offer is fulfilled completely, the automated system of *Adams* removes the offer from further consideration by the system. Conversely, and in the second scenario, the offer is kept in the book and adjusted to reflect the remaining quantity if the quantity transacted is less than the quantity of the original offer. (Column 10, lines 50-52). Stated differently, if some portion of the offer goes unfulfilled, the quantity is updated and the offer remains on the books. In neither of these scenarios, however, is the purchaser allowed to make the adjustment or is the adjustment taken into account in the total cost to the purchaser.

For at least these reasons, Appellants submit that neither *Gindlesperger*, *Adams*, nor their combination disclose, teach, or suggest the features recited in Claims 5 and 15. Accordingly, Appellants respectfully submit that the rejections of Claims 5 and 15 are improper and should be reversed by the Board.

E.   The proposed combination of references is improper

With respect to the Examiner's proposed combination of *Adams* with *Gindlesperger*, the Examiner has not shown anything in *Gindlesperger*, *Adams*, or in the knowledge generally available to those of ordinary skill in the art at the time of the invention that would have taught, suggested, or motivated one of ordinary skill in the art at the time of the invention to combine these references in the manner the Examiner proposes. As discussed above, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill in the art at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. To avoid burdening the Board, Appellants have chosen not to repeat the entirety of Section II.B. here. Appellants trust that the Board is fully aware of the strict legal standard the Examiner must satisfy. The mere possibility that the teachings of one reference -- *Adams* -- might improve the teachings of another reference -- *Gindlesperger* --, as the Examiner asserts, does not even remotely provide the required teaching, suggestion, or motivation to combine these references.

The Examiner's summary conclusion at page 8 of the Final Office Action that it would have been obvious to a person of ordinary skill in the art at the time of Appellants' invention to "have modified the *Gindlesperger* reference to include the teachings of the *Adams* patent so as to . . . keep the vendors informed of the status of the process, while ensuring a secure and fair environment" is not supported by any teaching, suggestion, or motivation in *Gindlesperger*, *Adams*, or knowledge generally available to those of ordinary skill in the art at the time of Appellants' invention. (Final Office Action, page 8, [sic]). Similarly, the Examiner's summary conclusion that it would have been obvious to a person of ordinary skill in the art to "have modified the *Gindlesperger* system to include the teachings of the *Adams* patent so as to allow the purchaser to make modifications in case there are discrepancies and/or errors, and to allow the transactions in the system to be modified so as to ensure all the available quantities are bought and sold" is also not supported by any teaching, suggestion, or motivation in *Gindlesperger*, *Adams*, or knowledge generally available to those of ordinary skill in the art at the time of Appellants' invention. (Final Office Action,

page 8). To the contrary, the Examiner's conclusory statements are mere speculation and do not provide the suggestion or motivation necessary to make the proposed combination. Since the Examiner has not provided a sufficient teaching, suggestion, or motivation in the prior art, the Examiner's conclusion of obviousness is improper under the M.P.E.P. and governing Federal Circuit case law.

Furthermore, even if *Adams* discloses the elements of Appellants' Claims 4-5, 13, and 15, as suggested by the Examiner and disputed by Appellants above, Appellants respectfully submit that *Gindlesperger* teaches away from the proposed combination of references. As discussed above, *Gindlesperger* discloses that "knowing beforehand that the award will go to the lowest responsive and responsible bidder each participating vendor will have an incentive to submit their lowest bid upfront, rather than hold back their lowest bid, as they would be inclined to do if the award was still going to be negotiated after bid opening." (Column 10, lines 3-8). Thus, each vendor of the *Gindlesperger* system submits only one bid to be considered in determining the award. As a result, the bidding process of *Gindlesperger* is competitive only in the fact that a vendor's one bid is compared against every other vendor's one bid, and *Gindlesperger* teaches away from a combination of *Gindlesperger* with any other reference(s) to result in a system that encourages competitive and repetitive bidding between vendors. Accordingly, one of ordinary skill in the art would not be motivated to combine *Gindlesperger* with *Adams* as proposed by the Examiner.

F.   The Examiner has used improper hindsight reconstruction

In making the proposed *Gindlesperger-Adams* combination, the Examiner simply relies upon hindsight. Appellants respectfully submit that the M.P.E.P. and governing Federal Circuit case law summarized above clearly prohibit the hindsight reconstruction the Examiner has employed in making these rejections. To reiterate the pronouncement of the Federal Circuit provided in Section II.B. above:

> Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.* Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a

blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted). Appellants respectfully submit that the Examiner has employed the type of hindsight reconstruction explicitly forbidden by the M.P.E.P. and Federal Circuit.

For at least these reasons, the Examiner failed to show that the *Gindlesperger-Adams* combination discloses, teaches, or suggests limitations specifically recited in dependent Claims 4-5, 13, and 15. Dependent Claims 4-5, 13, and 15 are therefore patentable over the *Gindlesperger-Adams* combination. Appellants respectfully submit that these rejections are improper and should be reversed by the Board.
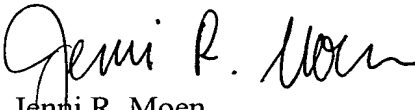
Conclusion

Appellants have demonstrated that the present invention, as claimed, is clearly distinguishable over the prior art cited by the Examiner. Therefore, Appellants respectfully request the Board to reverse the final rejections and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

Appellants enclosed a check in the amount of $500.00 with the Appeal Brief submitted for filing on April 12, 2005. Appellants believe that no other fees are due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

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Date: August 8, 2005

Correspondence Address:

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Appendix A

IN THE CLAIMS:

1.   **(Previously Presented)** An electronic bidding system, comprising:

means for enabling each of a plurality of vendors to submit electronic vendor bids on at least two parameters associated with a product, the electronic vendor bids submitted over an electronic communications network;

means for calculating a total cost of the product to a purchaser for each vendor in response to the vendors bids, the total cost taking into account the at least two parameters associated with the product; and

means for outputting each of the vendors bids and the total cost of the product to the purchaser.

2.   **(Original)** The bidding system of Claim 1, wherein the bids include a plurality of parameters for the product and the total cost calculating means determines the total cost of the product to the purchaser using a pre-determined total cost formula.

3.   **(Original)** The bidding system of Claim 2, wherein the total cost formula includes at least one pre-defined constant.

4.   **(Original)** The bidding system of Claim 1, further comprising:

means for communicating a vendor bid having the best total cost for the product to the vendors without revealing the identification of the vendor with the best total cost to encourage competitive bidding by the other vendors.

5.   **(Original)** The bidding system of Claim 1, further comprising:

means for enabling the purchaser to make at least one adjustment corresponding to at least one of the vendor bids which is used by the calculating means to determine the total cost of the product to the purchaser.

6.   **(Original)** The bidding system of Claim 1, further comprising:

means for enabling communication with the vendors during the bidding.

7.   **(Original)** The bidding system of Claim 6, wherein said communication means enables messages to be sent to the vendors to encourage further bidding by the vendors.

8.   **(Original)** The bidding system of Claim 7, wherein said communication means enables messages to be sent to the vendors regarding the status of the bidding, ending time for the bidding and extensions of the bidding.

9.   **(Previously Presented)** The bidding system of Claim 1, further comprising:

means for calculating an amount of savings for the purchaser and means for communicating the savings to the purchaser.

10.   **(Original)** The bidding system of Claim 1, further comprising:

means for setting up the bidding on the product.

11.   **(Original)** An electronic auction system, comprising:

a computer readable storage medium;

software stored on the computer readable storage medium and operable to receive bids from a plurality of vendors, each bid comprising a plurality of parameters associated with at least one product, calculate the total cost of the at least one product to a purchaser for each vendor in response to the vendors' bids, the total cost taking into account the plurality of parameters associated with the at least one product, and output each of the vendors bids and the total cost of the product to the purchaser.

12.   **(Previously Presented)** The electronic auction system of Claim 11, wherein the at least two parameters are selected from a group consisting of price, discount, delivery, installation, training, maintenance, the risks covered by warranty, and length of warranty.

13.   **(Original)** The electronic auction system of Claim 11, wherein the software is further operable to send data, comprising a vendor bid having the best total cost for the product, to the vendors during the auction without revealing the identification of the vendor with the best total cost.

14.   **(Original)** The electronic auction system of Claim 11, wherein the software is further operable to send data to the vendors during the bidding to stimulate competitive bidding.

15.   **(Original)** The electronic auction system of Claim 11, wherein the software is further operable to enable the purchaser to make at least one adjustment corresponding to at least one vendor bid which is used by the central auction management system to calculate the total cost of the product to the purchaser.

16.   **(Original)** The electronic auction system of Claim 11, wherein the total cost calculated for each vendor uses a single formula for all vendors.

17.   **(Original)** The electronic auction system of Claim 11, wherein the total cost calculated for each vendor uses a plurality of formulas, each vendor having one of the plurality of formulas associated with it.

18.   **(Original)** The electronic auction system of Claim 11, wherein the plurality of parameters is further associated with a plurality of products.

19.   **(Original)** The electronic auction system of Claim 11, wherein the auction results take into account vendors bids on a market basket of products.

20.   **(Previously Presented)** The electronic auction system of Claim 11, wherein bids from vendors are received through an Internet.

21.   **(Original)** The electronic auction system of Claim 11, wherein the software is further operable to provide a vendor with data about the status of an auction while the auction is in progress.

22.   **(Original)** The electronic auction system of Claim 11, wherein the software is further operable to provide a purchaser with data about the status of an auction while the auction is in progress.

23.   **(Original)** The electronic auction system of Claim 11, wherein the software is further operable to control which vendors are allowed to participate in an auction.

24.   **(Original)** The electronic auction system of Claim 11, wherein the software is further operable to allow a total cost formula to be defined for each product in an auction.

25.   **(Original)** A method of conducting an on-line auction, comprising:

receiving bids from a plurality of vendors, each bid comprising a plurality of parameters associated with at least one product, calculating, using a computer, the total cost of the at least one product to a purchaser for each vendor in response to the vendors' bids, the total cost taking into account the plurality of parameters associated with the at least one product, and outputting, using the computer, each of the vendors bids and the total cost of the product to the purchaser.

26.   **(Original)** The method of Claim 25, further comprising:

defining a plurality of parameters for a category of products; and

defining a total cost formula for the category of products in response to the plurality of parameters.

27.   **(Original)** The method of Claim 26, wherein the total cost formula includes at least one constant associated with at least one parameter.
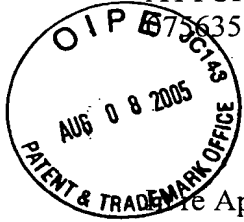
28.   **(Original)** The method of Claim 25, wherein the plurality of parameters includes price and non-price parameters.

29.   **(Original)** The method of Claim 28, wherein the price parameters include at least one of a base price, volume discounts, rebates, life cycle discounts, utilization charges, maintenance charges and administration charges.

30.   **(Original)** The method of Claim 28, wherein the non-price parameters include at least one of delivery timing, national service coverage, minimum quality levels, employee skill levels, a dedicated account management team, special reporting requirements, online ordering, warranty and length of contract.

31.   **(Original)** The method of Claim 26, wherein defining a plurality of parameters comprises defining at least two sub-categories for the category of products, and defining at least two parameters for each subcategory.

32.   **(Original)** The method of Claim 25, further comprising:

communicating the best vendor's bid to the other vendors to encourage competitive bidding.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Thomas H. Slaight et al.
U.S. Patent Serial No.:	09/737,697
Filing Date:	December 14, 2000
Examiner:	Sandra S. Snapp
Group No.:	2915
Title:	SOURCING SYSTEM AND METHOD

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that the enclosed Corrected Appeal Brief with attached Appendix A (Claims on Appeal), Appendix B (Gindlesperger), Appendix C (Adams), Appendix D, and Appendix E (94 pages), Baker Botts return postcard (1 postcard), and this Certificate of Mailing are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on this 8th day of August 2005, addressed to the Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Willie Jiles
Willie Jiles

Express Mail Receipt
No. EV 323317660 US

Appendix D

Evidence Appendix

Other than the references attached to the Appeal Brief as Appendices B-C, no evidence was submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, and no other evidence was entered by the Examiner and relied upon by Appellants in the Appeal.

Appendix E

Related Proceedings Appendix

As stated on page 3 of the Appeal Brief mailed April 4, 2005, to the knowledge of Appellants' Counsel, there are no known appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision regarding this Appeal.